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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/550,623

06/27/2006

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J3714(C)

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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT

PAPER NUMBER

1619

NOTIFICATION DATE

DELIVERY MODE

02/19/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentgroupus@unilever.com

Office Action Summary	Application No. 10/550,623	Applicant(s) IVANOVA ET AL.	
	Examiner JYOTHSNA A. VENKAT	Art Unit 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12 is/are pending in the application.
- 4a) Of the above claim(s) 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>05/25/2006;09/11/2008;10/28/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Receipt is acknowledged of election filed on 10/22/09 and IDS filed on 10/28/09; 9/11/08 and 5/25/06. **Claim 11 drawn to non-statutory subject matter has been cancelled** and claim 12 has been added as per applicants' amendment dated 10/22/09. Claims 1-10 and 12 are pending in the application.

Election/Restrictions

Applicant's election with traverse of group I in the reply filed on 10/22/09 is acknowledged. The traversal is on the ground(s) that the two groups are drawn to product and method of use and examining both the groups in single application do not impose search burden. This is not found persuasive because groups I-II do not relate to single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the reasons stated in the restriction requirement.

The requirement is still deemed proper and is therefore made FINAL.

Claim 10 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 10/22/09.

Claims 1-9 and 12 are examined in the application.

U. S. Patent 6,787,130 and WO 03/028,677 belong to the same patent family.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-9 and 12 are rejected under 35 U.S.C. 103(a) as being obvious over the combination of (U. S. Patent 6,787,130 or WO 03/028,677) and U. S. Patent 5,674,478 ('478) .

U. S. Patent 6,787,130 or WO 03/028,677 belongs to the same patent family. Because WO 03/028,677 and US 6,787,130 appear to have identical disclosures, for simplicity they will together be referred to hereinafter as "'130". While any reference hereinafter to column and line numbers will be based upon the US patent disclosure, such reference should be interpreted as including the corresponding disclosure of the aforementioned WO document.

The applied reference has a **common assignee** with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference

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under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Patent '130 teaches hair treatment compositions which provide hair body and shine comprising claimed silicone pressure sensitive adhesive. See the abstract. See col.3, line 53 through col.4, line 66 for claimed pressure sensitive adhesive (claim 12). See claim 10 of the patent for "leave-in" composition. Leave-in or leave-on compositions are the same since they are not washed off from the hair.

See col.3, ll 44-45 for the conditioning agent (claim 4).

See claim 8 of patent at col.23, ll 1-2 for the limitation of claim 5.

See col.4, ll 64-68 (claims 6-7).

See Claim 8 at col.23 for the limitation of claim 8

See col.5, ll 29-33 for the limitation of claim 9 .

The difference between '130 and instant application is patent '130 does not teach claimed hair formulation in the form of mousse, cream lotion or spray and compositions comprising propellant, which is hydrocarbon gas.

However, patent '478 teaches hair conditioning compositions. Hair conditioning compositions are "leave-on" compositions unlike shampoo, which are "rinse-off"

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compositions. Patent teaches mousse at col.13 and aerosol hair spray at col.14, which has propellant and the hydrocarbon is isobutane.

Accordingly, it would be obvious to one of ordinary skill in the art at the time the invention was made to use hair treatment compositions for leave on using the claimed silicone pressure sensitive adhesive taught by patent '130 and use in the form spray or mousse taught by patent '478 which teaches leave on compositions using the known formulations in the form of mousse and aerosol sprays. This is prima facie case of obviousness.

Claims 1-9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patent 5, 451, 610 ('610) and U. S. Patent 5,919, 439('439) .

Claims are drawn to compositions and the intended use as “ hair treatment “ does not carry any patentable weight.

Patent '610 teaches a method of enhancing adherence to the skin or eyelashes containing as an active ingredient silicone pressure sensitive adhesive as a film forming agent. See the abstract. Patent at col.2, ll 10-54 teaches the claimed silicone pressure sensitive adhesive and under table 1 teaches water and thus forms emulsions. See also col.5, ll 1-25 for pressure sensitive adhesive in the form of emulsions. Patent at col.9 and col.10, line 23 teaches adding solvents which are silicones and at col.10, line 31 through col.11, line 55 teaches adding surfactants. The difference between the patent and instant application is patent does not teach the claimed pressure sensitive adhesive in the form of mousse or aerosol sprays with propellants and comprising a conditioning agent and the amount of solvent, which is 20-80%.

Patent '439 teaches hair and skin care compositions using dispersible silicone grafted thermoplastic elastomers . Patent '439 at col.7, ll 12-35 teaches that these silicone copolymers

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provide smooth and silky feel to the hair and also provide film forming properties to skin. Patent '439 at col.21, ll 30-40 teaches that the silicone copolymers are formulated into a wide variety of product types like conditioners, mousses, lotions, sprays and at col.21, ll 45-50 teaches the carrier and the weight percent is 0.5-99.5% and at col.22, ll 6-12 teaches silicones as carriers and at col.22, ll 12-36 teaches hair care compositions that can be in the form of mousse sprays and teaches that mousses and sprays can include propellants and this includes hydrocarbons like propane, butane and also teaches spray products can include surfactants. Patent at col.24, ll 6-10 teaches the amounts of pharmaceutically active components to be present in the compositions and at col.26, ll 10-49 teaches conditioning agents as pharmaceutically actives. Patent at col.27 through col.28, line 42 teaches adding surfactants.

Accordingly it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions using the silicone pressure sensitive adhesive of patent '610 in the form of emulsion and use it for hair and use higher amount of silicones as the carrier along with conditioning agents and use the hair care formulations in the form of mousse or sprays or lotions taught by patent '439 which uses analogous silicone polymers. One of ordinary skill in the hair care art would have reasonable expectation of success that by using the silicone pressure sensitive adhesive for hair instead of eyelashes the silicone pressure sensitive adhesive forms a film on the hair and thus provide style to the hair and having a conditioning agent provide conditioning properties to hair. This is a *prim facie* case of obviousness.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, EYLER YVONNE (BONNIE) can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /
Primary Examiner, Art Unit 1619